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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 720.

MILCOR STEEL COMPANY,

Petitioner,

vs.

GEORGE A. FULLER COMPANY, NEFF LATHING COMPANY, INC., and CONVER STEEL & WIRE COMPANY, INC.,

Respondents.

BRIEF FOR RESPONDENTS.

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Additional Statement of the Case.

It is well for a general understanding of the circumstances preceding respondents' Motion to Dismiss to point out that, prior to answer, the petitioner narrowed the issues of this case by asserting that it relied upon claims 6 and 7 only of the single patent in suit in support of its charge of infringement (R. 5, paragraph 2 of petitioner's Bill of Particulars). Respondents, in their answer, replied to this charge by asserting the anticipation of the constructions of claims 6 and 7 by four prior art patents (R. 8) including

U. S. Letters Patent to Orr, No. 913,152, dated February 23, 1909 (R. 35).

Approximately two and one-half months after issue was thus joined and defendants, respondents here, had disclosed the anticipatory prior art upon which they intended to rely at trial, plaintiff, petitioner here, filed in the United States Patent Office a paper which was headed "Disclaimer" (R. 10 and 11) and purported to amend the only two claims in suit, to wit: claims 6 and 7 of Holdsworth patent No. 2,105,770, granted January 18, 1938. Pursuant to the filing of the disclaimer, respondents brought their motion for summary judgment (R. 12). The courts below unanimously held the purported disclaimers invalid.

At page 7 of petitioner's brief we find the following paragraph:

> "That the Holdsworth patent in suit illustrates and describes an invention patentable over the prior art; that Holdsworth was the first to render available to the public the practical and advantageous wall construction fully disclosed in the patent, and that Respondents have appropriated the said invention, are not challenged at this status of the litigation."

So that there is no chance for this Court to gain a misimpression, we wish to state that, as the pleadings stand now, both infringement and validity of the two claims at bar, as they originally read and as they read with the purported disclaimers, are expressly denied. The manner of disposition of the case by the courts below has rendered further inquiry into these questions unnecessary up to the present time.

Summary of Argument.

1. The purported disclaimers clearly seek to add physical elements to each of the only two claims in suit and are accordingly invalid disclaimers under the authorities, including Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477.

2. The petitioners would have this Honorable Court believe that a holding that all modifying disclaimers are invalid is necessary, on the facts in this case, to find for respondents. If is only necessary that this court affirm its former ruling in the Altoona case, to the effect that the addition of elements by disclaimer is an invalid practice, to sustain the courts below.

3. The equities of the present case and the evils of misuse of the disclaimer statute are such that the voluntary unexaminable act of a patentee in disclaiming without entirely relinquishing a claim should be examined with care and every doubt should be resolved against the voluntary "disclaimant".

ARGUMENT.

1. General Nature of the Construction in Question.

To familiarize the court with the general nature of the subject matter of this suit, reference is had to the simple and readily understood disclosure of the patent to Orr No. 913,152, dated February 23, 1909, relating to partition walls. This patent is found in the Record at page 35, is discussed by Mr. Robertson in his affidavit in support of the motion for summary judgment (R. 16), and is stated to be the closest prior art patent in an affidavit filed on behalf of petitioner in which the details of its construction are discussed (R. 26).

W. ORR.

FIREPROOF PARTITION.

APPLICATION FILED OCT. 12, 1907.

913,152.

Patented Feb. 23, 1909.

Fig 1

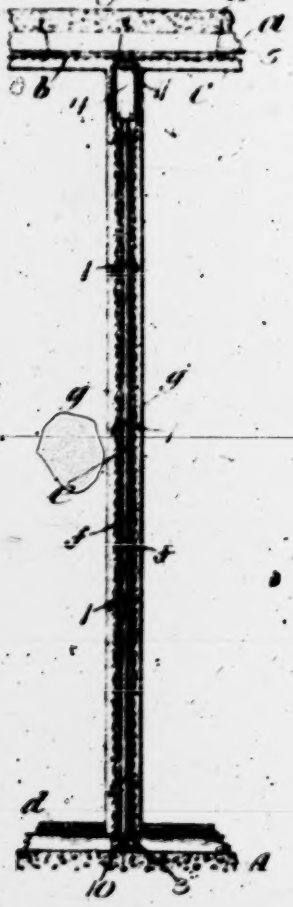


Fig 2.

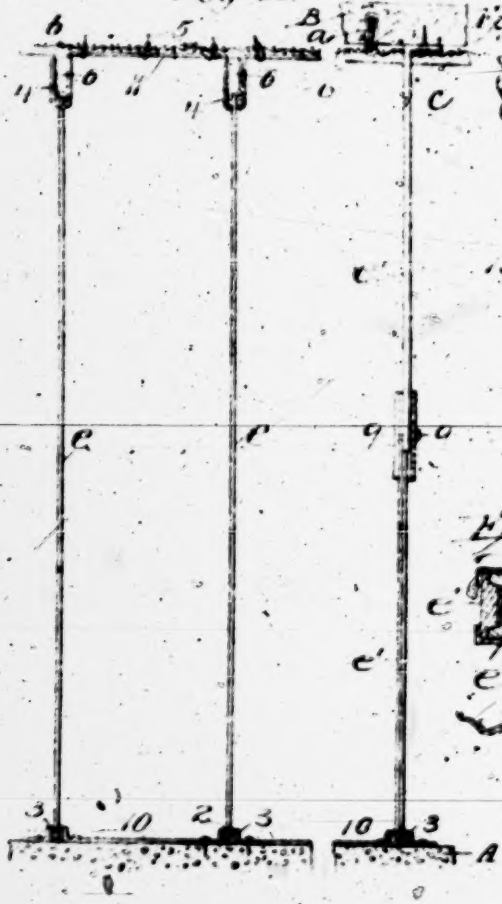


Fig 8

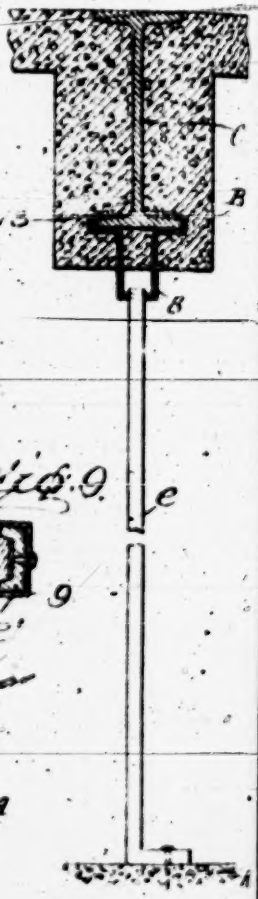


Fig 7

Fig 9.

Fig 5.

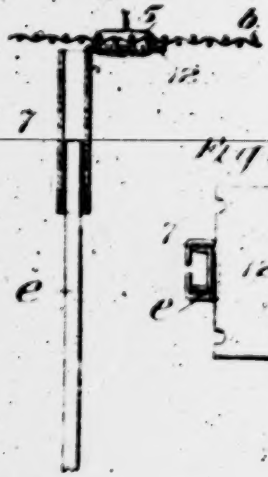


Fig 6

Fig 3.

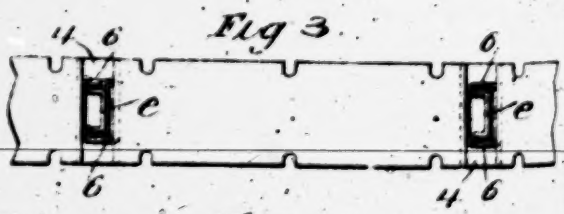
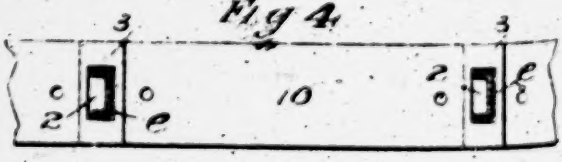


Fig 4.



Witnesses
[illegible]
[illegible]

Inventor
William Orr
by his Attys
[illegible]

For convenience of reference, the drawing of the Orr patent is here reproduced. Fig. 1 is a section through a non-load bearing or partition wall. Referring to Fig. 2, the skeletal framework of the wall is formed by upstanding wall-supports of channel cross-section designated e. These channels are assembled with floor members designated 10 having raised portions 3 formed to receive the lower ends of the channel wall-supports, as shown in detail in the plan view Fig. 4. Ceiling members 11 having downwardly extending formations 4 apertured to receive the upper ends of the channel wall-supports e, as shown in detail in the plan view Fig. 3, complete the skeleton assembly over which wire mesh is laid for carrying and supporting the plaster.

Orr states:

> "The partition, in the form shown, consists of the metal studs e, to which is laced on one or both sides by wires 1 the metallic lathing f, to which is applied the plaster g to complete the partition, the partition shown being of that class known as 'solid partitions' with no central air space." (R. 36, lines 89 through 95.)

Obviously, Orr's partition framework is assembled by inserting his channel-shaped stud in the apertures of the downward formation 4 of the ceiling member 11, then raising the stud until its lower end may be dropped into the raised ports 3 of the floor members 10.

Petitioner attaches significance to the fact that subsequent to the disclaimer respondents amended their answer so that the total number of prior art patents of record is now thirty-five (its brief, page 9). Does petitioner wish to impart like significance to the fact that respondents' original answer, prior to the disclaimer, set up only four

prior art patents? Confessedly this does not affect the issue before this court, but we wish merely to discountenance petitioner's innuendo in this connection.

The construction shown in the Holdsworth patent (R. 30), like that to Orr, is relatively simple. Figs. 1 and 2 of the Holdsworth patent show a conventional floor and ceiling of any construction between which it is desired to extend a vertical partition wall. Secured to the floor is a band or ribbon of metal, designated 3, which has alternate portions extending along the floor, see 5 in Fig. 5, and other portions raised from and extending parallel to the floor. In such raised portions there are U-shaped formations which provide recesses numbered 4. This strip or band 3 is the "base member" of the claims.

Secured to the ceiling 2 is an elongate angle iron 7 having one flange secured directly against the ceiling and its other flange depending therefrom. This element is the "ceiling member" of the claims. The angle iron form of ceiling member is set forth in the specification by way of example and its specific form is expressly disclaimed as having any patentable significance (Holdsworth specification p. 2 column 2, lines 43-47; R. 32).

Reference to Figs. 1 and 2 shows vertical members 6 extending between the base member and the ceiling member and adapted to be assembled with those members. The vertical members 6 are the "upstanding wall-supports" of the claims. In the form illustrated specifically in the Holdsworth drawing, such members are notched at their upper ends as at 8 in Fig. 2, and the notches, when the parts are assembled, extend downwardly farther than the terminal portion of the ceiling member 7 whereby the ele-

ments 6 may be vertically moved relative to the base and ceiling member, and the specification of the patent states that this is provided for assembly and to permit the use of vertical members varying in length. (The Holdsworth specification, page 2, column 1, lines 2 through 10, Record 32).

2. The Purported Invention of Original Claim 6.

Claim 6, as it read when passed upon and allowed by the Patent Office and as it read when this action was brought and the acts complained of committed, and as it read when respondents filed their answer and asserted the prior art patents, including the one to Orr, which anticipated the claim, read as follows:

> "6. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member, said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member, said wall supports being vertically movable relative to said base member and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, and means operative to prevent any substantial tilting movement of said wall supports from their predetermined upstanding position."

Disregarding what appears to us to be prolixity in the form of the claim, it will be found that the elements recited in original claim 6 were the following:

(a) a base member,

(b) a ceiling member,

(c) upstanding wall supports whose height is less than the maximum vertical distance between said base member and said ceiling member, and

(d) means operative to prevent any substantial tilting movement of said wall supports.

In looking at the disclosure and specification of the Holdsworth patent to determine what is and what is not an inherent part of his claims, aside from the literal context of the claims, it is interesting to note the following unequivocal statement in his specification, page 2, column 2, lines 43 through 47 (R. 32):

> "Whenever I refer to channel irons, I do not wish to be limited to any form of vertical supporting members, and I do not wish to be limited to an angle iron for completing the top of the metal construction."

Original claim 6 of the patent in suit purported to cover broadly a wall structure wherein there are provided vertical studs and means at the ceiling and floor for positioning the studs. This much, of course, is old and well known. The gist of original claim 6, as is apparent on its face, is the fact that the stud lengths are so proportioned that each stud may be inserted in the ceiling member and moved upwardly, beyond its normal assembled position, and then dropped down into the floor member. As set forth in the original patent, there was nothing whatever in claim 6 as to the particular elements comprising the ceiling member. The closest claim 6 comes to any specification of the relation between "upstanding well-supports" and "base and ceiling members" is to say that the former is vertically moveable with respect to the latter, lines 9 and 10, and an inference that the two elements are "assembled", lines 11 and 12.

We emphasize that nothing in claim 6, which is supposed to particularly point out the patentee's invention, directs the public even remotely to suspect that the patentee con-

siders his invention to reside in a particular manner of associating the upstanding wall-supports and the ceiling member. Not only that, but we have the patentee's clear and specific injunction against considering his invention to concern an "angle iron for completing the top of the metal construction."

3. The Purported Disclaimer to Claim 6 and the Doctrine of Altoona Publix Theatres v. American Tri-Ergon Corp.

The amendatory disclaimer to claim 6 is as follows (R. 34):

> "As to claim 6, except a wall construction for a room in which the ceiling member comprises a vertical depending perforated flange, one side of which is overlapped by metal lathing."

It will be noted that in addition to the four elements of original claim 6, to wit: the base member, the ceiling member, upstanding wall-supports, and the means for preventing tilting of the wall-supports, plaintiff has sought to add by disclaimer two definite physical elements:

(1) a vertical depending, perforated flange on the ceiling member, and

(2) metal lathing.

This is exactly the type of disclaimer which this Court struck down in the Altoona case. To argue and compare numerous other cases decided by other Circuit Courts of Appeals and far less in point than the Altoona case is not especially helpful. It tends to obscure the clear issue presented in this case. The Altoona case and the present one are four-square.

The similarity between what was attempted to be done in the case of apparatus claim 13 in the Altoona case and what appellant has here sought to do in the case of claims 6 and 7 of the Holdsworth patent is too striking and decisive to be satisfactorily answered by the labored reasoning at the bottom of page 19 of petitioner's brief. It appears obvious that the "means for imparting * * * uniform motion" of the original claim is the "flywheel" of the disclaimer.

A comparison of the status of the "vertical flange" of the amendatory disclaimer to claim 6 of the Holdsworth patent with that of the additional element of claim 13 of the patent in suit in the Altoona case leaves no ground for distinguishment. In the Altoona case *original* claim 13 had as an element "means for imparting to the film a rapid and uniform motion * * *." The purported disclaimer to claim 13 was in the following language:

> "The combination as set forth in claim 13, except wherein a flywheel is operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film."

This Honorable Court, speaking through the present Chief Justice, said, in invalidating the patent:

> "While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combination originally appearing in claims 9 and 13 only when used in conjunction with a flywheel, it also operated to add the flywheel as a new element to each of the combinations described in the claims."

Note particularly that original claim 13 in the Altoona case specified broadly "means for imparting to the film a rapid and *uniform* motion * * *"; just as in the present case, claim 6 originally specified broadly a "ceiling member." (Italics ours.)

The opinion of this Court in the Altoona case so fully and completely deals with the identical disclaimer situation presented in the present case that counsel for respondents feel compelled to set forth the pertinent portion of that opinion, despite its length:

"* * * The Court below made no reference to the contention of petitioner, urged here and below, that the patent was rendered invalid by the disclaimer filed shortly before the trial of the present suit. The patent as issued contained the following claims:

* * * * * *

"'13. An apparatus for reproducing speech, music or the like sounds from vibrations recorded on a film, by the use of a line of light varied in accordance with the sound, comprising a photo-electric cell, means for imparting to the film a rapid and uniform motion longitudinally of the film past said cell, a source of light projection for providing said light, and an objective lens in the path of said light and spaced from the film for directing said light as a converging narrow line impinging on the film at a point in the region of the focal point of said lens, said light passing through the film and on to said cell, the space between said lens and the film being free of obstructions to said light.'

"In 1933 respondents, by appropriate procedure, disclaimed:

* * * * * *

"'(c) The combination as set forth in claim 13, except wherein a flywheel is operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film.'

"While the effect of the disclaimer, if valid, was in one sense to narrow the claims, so as to cover the combinations originally appearing in claims 9 and 13 only when used in conjunction with a flywheel, it also operated to add the flywheel as a new element to each of the combinations described in the claims. The disclaimer is authorized by Rev. St. 4917 (35 USCA 65), which provides that, when 'through inadvertence, ac-

cident, or mistake * * * a patentee has claimed more than that of which he was the * * * inventor * * * his patent shall be valid for all that part which is truly and justly his own,' provided that he or his assigns 'make disclaimer of such parts of the thing patented as he shall not choose to claim * * * stating therein the extent of his interest in such patent.' While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination.

"If a change such as the present could validly be made, it could only be under the provisions of the reissue statute; Rev. St. 4916, amended by Act May 24, 1928 (35 USCA 64), which authorizes the alteration of the original invention in a reissued patent, upon surrender of the old patent, for its unexpired term. Upon the reissue, 'the specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are.' A patent amended by disclaimer thus speaks from the date of the original patent, while the reissued patent, with respect to the amended claim, speaks from the date of reissue. If respondent could thus, by disclaimer, add the flywheel to the arcuate flexing claim and to the optical claim, he would in effect secure a new patent operating retroactively in a manner not permitted by the reissue statute and without subjecting the new claims to revision or restriction by the customary Patent Office procedure required in the case of an original or reissued patent. Such transformation of a patent is plainly not within the scope of the disclaimer statute, and the attempted disclaimer as applied to claims 9 and 13 is void. Hailes v. Albany Stove Co., 123 U. S. 582, 587, 8 S. Ct. 262, 31 L. Ed. 284. See Union Metallic Cartridge Co. v. United States Cartridge Co., 112 U. S. 624, 642, 5 S. Ct. 475, 28 L. Ed. 828; Collins Co. v. Coes, 130 U. S. 56, 68, 9 S. Ct. 514, 32 L. Ed. 858. Compare

Grant v. Walker, 148 U. S. 547, 553, 13 S. Ct. 699, 37 L. Ed. 552.

* * * * *

"With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim or to hold by virtue of the patent.' Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public.

"While the precise effect of an invalid disclaimer upon the original claim seems not to have been judicially determined, analogous principles of the patent law are so well recognized as to leave no doubt what our decision should be. It has long been settled that a claim abandoned or rejected in the Patent Office with the acquiescence of the applicant cannot be revived in a reissued patent. Yale Lock Mfg. Co. v. Berkshire Nat. Bank, 135 U. S. 342, 379, 10 S. Ct. 884, 34 L. Ed. 168; Dodson v. Lees, 137 U. S. 258, 263-265, 11 S. Ct. 71, 34 L. Ed. 652. * * *"

If the disclaimer to claim 6 merely added the vertical flange to the ceiling member it would render the claim void under the doctrine of the Altoona case. A much stronger case is presented in the present situation, where the disclaimer goes on to add an element for which there is no possible or conceivable justification or antecedent in the original claim. This second added element is the metal lathing of the last line of the disclaimer. To quote: "* * *

one side of which (the vertical flange) is overlapped by metal lathing." (Parenthetical matter ours.)

That this latter addition to the claim is a new element is incontrovertible. That such addition of a new element render the claim void on its face is the well settled law.

The petitioner, at the last two lines of page 15 of its brief—and continuing on page 16, states that the "metal lathing" is not an added element. It seems to seek to divert attention from the "vertical depending perforated flange."

With respect to the paragraph beginning at the bottom of page 15 of petitioner's brief and ending at the top of page 16, it seems pertinent to inquire: "What depending flange?" There was no "depending flange" in original claim 6.

The fact is that the disclaimer to claim 6 not only adds two new elements but seeks to establish a new cooperation between the very two elements so added.

4. Original Claim 7 and the Amendatory Disclaimer Thereto.

Original claim 7 read as follows:

> "7. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member, said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member, said wall supports being vertically movable relative to said base member

and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, *said base member and said ceiling member being shaped to provide* means *which are* operative to prevent any substantial tilting of said wall supports from their predetermined upstanding position." (Italics ours.)

The italics indicate words in claim 7 not present in claim 6. The only other difference between claim 7 and claim 6 is that in the latter, the word "and" before the last means is omitted and the word "movement" after tilting is likewise omitted. With these exceptions the claims are word for word duplicates. In actual substantive content they were originally to the same structure and distinguishable only by the most careful scrutiny.

The elements of original claim 7 were:

(a) a base member,

(b) a ceiling member,

(c) upstanding wall-supports whole height is less than the maximum vertical distance between said base member and said ceiling member, and

(d) means (shaped in said base member and said ceiling member) to prevent * * * tilting.

The disclaimer to claim 7 (R. 34) reads as follows:

"(b) As to claim 7, a wall construction for a room in which the base member is composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports, the flanges of the channel wall supports overlapping the base member adjacent the recesses."

Attention is recalled to the fact that original claim 7 differed from original claim 6 only minutely, in fact only in

the particular language in which the means for preventing tilting, the last element of each of the claims, was expressed.

The purported disclaimer to claim 7 seeks to add "flanges" to the upstanding wall-supports and to assign to such flanges a particular cooperation with a base member of a particular kind. Note that there is absolutely no reference to flanges in the original claim and the original claim gives no notice to the public that the invention of that claim possesses any virtue by reason of the provision of flanges in conjunction with the upstanding wall-supports. The original claim specified nothing with respect to the upstanding wall-supports and as far as original claim 7 is concerned the use of ordinary two-by-four wood studs would answer the terms of the claim. Here again we refer to the patentee's own representation in his specification to the effect that his upstanding wall-supports are *not* limited in form to channel irons or otherwise; see the specification, p. 2, lines 43-47, column 2, (R. 32), quoted previously herein at page 8.

Patently, the purported disclaimer seeks to amend claim 7 and add, to the upstanding wall-supports, flange elements.

As with claim 6, the attempt to introduce a new and additional element by disclaimer is believed to be clear and irrefutable, and the claim is consequently rendered null and void.

5. The Two Claims Compared.

It is to be noted further in connection with claims 6 and 7 that the patentee takes two claims almost identical in original content (the only difference being the additional "said

base member and said ceiling member being shaped to provide" of claim 7), and seeks by amendatory disclaimer to direct one of the claims, claim 6, to allegedly novel cooperation between *a specific form of ceiling member* and the upstanding member and then, by further amendatory disclaimer embodied in the same document, seeks to direct the other claim, claim 7, to a specific allegedly novel cooperation of a specific upstanding member (having flanges) with a *specific base member*. None of the specific additional elements were present in the claims before the disclaimers and they were in face expressly disclaimed in the original specification (page 2, column 2, lines 43-47; R. 34).

6. The Use and Misuse of Disclaimers.

While in the present case the attempted disclaimer procedure violates the positive and specific injunction of this court against disclaimers adding elements and the claims are consequently void, there is further reason, based on the desire for an orderly and judicious administration of the Patent Laws, for dismissing the present action. In discussing such further reason reference is had to the extremely well considered case of Fruehauf Trailer Co. v. Highway Trailer Co., 54 F. (2d) 691, which was affirmed by the Sixth Circuit Court of Appeals, 67 F. (2d) 558, *the latter opinion being relied upon by the Supreme Court in the Altoona case.*

In the trial court opinion in the Fruehauf case in 1931 Judge Tuttle spoke as one who had examined thoroughly into the subject of disclaimers and we feel that we can argue the equities of the situation in which the respondents here are placed no better than by referring the Court here to the pertinent portions of Judge Tuttle's opinion. The Court there says:

"In expressing my views about disclaimers I do so because I am interested in the subject and should be glad to be helpful in solving some of the troublesome problems presented by disclaimers. There is no inclination on my part to avoid the decisions which ought to guide this court. Every one interested in the subject of disclaimers recognizes that the law applicable thereto is still in a very unsettled state. Individual courts have not satisfied themselves as to just what are to be the final holdings upon this subject. Taking the decisions of the courts as a whole, we are still in a greater confusion. * * *

"* * * The question of the effect of a disclaimer on a claim in suit, and especially whether or not such a claim after modification by disclaimer still retains its presumption of validity, arises in this present case and requires determination by me. * * *

"* * * * The Patent Office does not consider any disclaimer as to the merits of its subject matter. If the courts are to give approval to disclaimers which so alter the claim that the resulting novelty disclosed by the modified claim is never passed upon by the Patent Office, then such claims should come to the court without any presumption whatever of validity. Thus the burden rests upon the plaintiff, the proposer of a disclaimer claim in such a patent, to prove it to be valid without the assistance of any presumption in that respect. If the law is to be that such disclaimers are to be permitted, and such claims are susceptible of being held valid, then they should come to the court without any presumption of validity.

* * * * *

"The great commercial interests of our country are striving to manufacture things for the public, and we want to encourage them to make things serviceable and cheap for the use of the public. They have the benefit of all these expired patents, and the right to acquire privileges under the unexpired patents by dickering with the patentees, their successors, and assigns. These business interests serving themselves and the public have to employ their lawyers to guide them. They want to make the best thing they can as cheaply as they can. They are honest, at least most of them. They do

not want to steal something that does not belong to them. On the other hand, they do not want to pay royalty where they should not pay it. If they can honestly escape it, they want to do that, and they have a right to do it. They employ their lawyers. They search these old patents, and live patents, to find out whether or not they can do the thing they want to do. The lawyers find these expired patents which still teach these old things which belong to the public. They find a new patent with claims reading directly on the old structures, and advise the client that the patent is void. Their client goes ahead and undertakes to manufacture the thing that he wants to make on the theory that the patent is void. He builds up his business and gets started. He is sued. Then a more thorough study of the art is made by counsel for plaintiff. He finds that the patent in suit claims broadly what was old. He finds in the drawings or specifications some little thing which differs from the old art and is like the thing that the defendant is doing. Then he disclaims everything in the world except that the defendant is doing and is ready for trial. * * * More than that, when the defendant comes to the trial of that case, he is forced to try out an issue that has never been presented in the Patent Office. The patentee claims to have invented something new at a time far remote from the time of trial. The issue is often one which was never dreamed of when the defendant set up his defense in his pleadings. The disclaimers were filed shortly before the trial in the case at bar. It is difficult for a court of equity to add its seal of approval to a procedure such as I have described.

" * * * To permit disclaimers of this kind at these late dates and particularly after the testimony has been taken, places a heavy burden upon the business world and creates many problems for the trial courts—all of these could be avoided by rejecting disclaimers of this kind and requiring patentees to resort to the Patent Office for relief by re-issue.

" * * * Speaking by way of illustration and with some exaggeration perhaps, the usual disclaimer claim is very much like a solid block of marble. The dealer in marble delivers the solid block and tells his purchaser

that it is a Madonna. When the purchaser complains, the dealer says: 'All you have to do is to knock off all of that block except what represents a beautiful Madonna.'

" * * * Although the claim calls for a block of marble, we are liable to get into court with a Madonna or a cigar Indian, depending on what picture may be hidden away in the patent gallery.

" * * * If we are to be burdened with disclaimers of this kind, then we must lay down a rule for these special types of claims whittled out in that sort of way that will not admit of a Madonna being converted into a cigar Indian, or vice versa at the whim of a plaintiff."

In affirming the trial court's decision the Circuit Court of Appeals said, at p. 559 of 67 F. (2d):

"We quite agree with the views expressed by the learned trial judge upon the subject of the disclaimers. The enactment of Rev. St. 4917 (35 USCA 65), was never intended to permit the revamping and rephrasing of claims to the end that they might cover structures upon which they did not before read, *or to the end that, by the addition of a new element in combination, the disclaimer might validate a claim which would otherwise be invalid under the prior art.* This is not limiting the combination already claimed; it is in effect claiming a new and a different combination. General Motors Corp. v. Rubsam Corp., 65 F. (2d) 217 (C. C. A. 6); Linville v. Milberger, 34 F. (2d) 386, 390 (C. C. A. 10); Albany Steam Trap Co. v. Worthington, 79 F. 966, 969 (C. C. A. 2.)"

7. The Authorities Relied Upon by Appellant.

The petitioner's persistence in arguing, by remote analogy, cases decided in various of the judicial circuits, seems pointless when the highest court of the land has ruled in a case which we challenge the appellant to distinguish from the present one? The petitioner seeks to show,

through a variety of less pertinent opinions arising in other circuits, that this Court did not mean what it plainly said. To "construe" the Altoona case as appellant urges here is to ignore it.

There can be found in cases decided prior to and since the decision of the Supreme Court in the Altoona case much dicta and many broad generalities with respect to the effectiveness of disclaimers. Often these statements of the propriety and effectiveness of disclaimers are made in cases where entire claims are completely disclaimed. In some others they are made with respect to claims originally presented in alternative form and where one of the alternatives is expunged from the claim by disclaimer. In any event, much of the obscurity and conflict of decision which has clouded the subject of patent disclaimers has been removed by the decision in the Altoona case.

The petitioner's "construing" of the Altoona case as found in the first full paragraph of page 20 of its brief is indeed devious. The succeeding paragraph of petitioner's brief is:

> "In order to invalidate a patent, the disclaimer must fulfill both of two conditions, as distinguished from either of said conditions, namely, a new element must be added, and the addition of the new element must also transform an original combination into a new and different combination."

The petitioner therein states that the Altoona decision did not place a ban on the addition of elements by disclaimer. This is not justified by that case and we again earnestly call the attention of this court to the fact that the "fly wheel" of the disclaimer of claim 13 of the patent in suit in the Altoona case, which was the obnoxious added

element, as the result of which the Supreme Court held the claim void, was far from being entirely foreign to the spirit of the original claim. It had its genesis in the broader recitation of "means for imparting to the film a rapid and *uniform motion*" of the original claim. To this extent the petitioner here finds itself in an even less tenable position than that of the patent owners in the Altoona case.

The petitioner's argument that the Altoona case is authority for the doctrine that the addition of a new element is not objectionable unless it produces a new combination (its brief, p. 20, lines 12 through 17) is believed to be specious. One may well question how anyone could conceivably claim a combination of elements a, b and c, add to that claim element d, and not produce a new combination.

In all of the cases relied upon by the petitioner the courts, whether correctly or incorrectly, decided that elements were *not* added and that consequently the doctrine of the Altoona case did not apply.

The first case discussed under this head in petitioner's brief is Byrne Mfg. Co. v. American Flange & Mfg. Co., 87 F. (2d) 783. In its brief petitioner begins a discussion of this case immediately following a statement to the effect that the Altoona decision has been considered and construed as contended for by appellant (its brief, bottom of page 20 and top of page 21), this in spite of the fact that the Altoona decision is nowhere alluded to in the Byrne Mfg. Co. v. American Flange & Mfg. Co. opinion, and for all that we know, was not considered by the court there.

Nevertheless, the Byrne case does distinguish from the Altoona case *without mentioning it* and in terms that are

unmistakable and need no construing. The court there said at page 784, last two lines:

"*The disclaimer adds no new elements.*" (Italics ours.)

The next case taken up by the petitioner is that of Cincinnati Rubber Mfg. Co. v. Stowe-Woodward, Inc., 111 F. (2d) 239. We fail to see the pertinence of this decision. The roll claimed in the claims prior to disclaimer is in no wise added to or subtracted from by the disclaimer. All that the disclaimer in the Cincinnati case does is to say that it claims its roll only for a particular use, to-wit: its use in contact with a moist web in a paper machine. The Altoona case is not mentioned in the Court's opinion and the court merely holds that elimination of a part of the field of applicability of an invention by disclaimer is proper.

The next case discussed by petitioner is Johnson Laboratories Inc. v. Meissner Mfg. Co., 98 F. (2d) 937. The petitioner chooses claim 1 of the patent there under consideration as illustrative. A footnote to the case sets forth claim 1 with the portion added thereto by disclaimer italicized. We quote that claim as disclaimed and as it appears in the footnote:

"1. A compressed comminuted magnetic material having (a) individaully-insulated particles and (b) a substantially constant permeability for a band of radio frequencies at least one octave wide. (c) *substantially all of the particles are capable of passing through a screen having 400 meshes to the inch (d) the compressed material has an apparent permeability of not less than 7, (1) at a frequency of from 300-1400 kilocycles: (2) at a magnetic intensity between 0.01 and 10 gauss (e) the compressed material has a resistivity of at least 10 ohms per centimeter cube.*" (The italicized portion is the part added by disclaimer.)

It will be noted that that claim originally called for certain physical structure including *comminuted magnetic* material. That meant material reduced to minute particles or to a fine powder. The only thing the plaintiff in that action did by the disclaimer, as is apparent from an inspection of claim 1 above, was to state that by "comminuted" he meant of a fineness capable of passing through a 400 mesh screen. Note particularly that every other word of the disclaimer to claim 1 is what the Patent Office calls "functional". In other words, the remainder of the disclaimer merely describes the inherent electrical qualities of the material claimed in the original claim.

The court recognized that the addition of elements by disclaimer is repugnant to the statute but held that no new element was added to the patent there in suit. In truth, the very fact that the court found no added elements was the basis for the decision in the Johnson case, and accordingly, that case has no applicability here. The court specifically stated at page 944, column 2, line 9, that a disclaimer is valid, under certain circumstances, "if no element is added". Again at page 945, column 2, the paragraph beginning at about the middle of the page, the court says:

> "Without discussing the specific limitation as to each claim affected by the disclaimer, what we have said with regard to Claim 1 is applicable to each one of them. *We think the disclaimer is within the statute, that it adds no new elements*, that it diminishes the scope of the claims of the patent without prejudicing the rights of any one. Byrne Mfg. Co. v. American Flange & Mfg. Co., Inc., 6 Cir., 87 F. 2d 783; Dunbar v. Meyers, 94 U. S. 187, 24 L. Ed. 34; Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477, 55 S. Ct. 455, 79 L. Ed. 1005. Consequently we shall consider the claims as limited by the disclaimer." (Italics ours.)

In discussing each of the three preceding cases in its brief, petitioner urges that the disclaimers in question were similar to the disclaimers to claims 6 and 7 of the patent here in suit. We submit that the disclaimers here under examination in reality resemble much more the one to claim 13 of the patent involved in the Altoona case than they resemble those of the three cases just discussed.

The Payne Furnace and Supply Co. Inc. v. Williams-Wallace Co. case, 48 U. S. P. Q. 575, which is the next referred to by petitioner, was decided by the Ninth Circuit Court of Appeals with a dissenting opinion by Judge Matthews. The Court of Appeals in the Payne case was obviously moved to act as it did because it felt that the disclaimer appeared unnecessary in any event. This immateriality made the argument against the disclaimer one based strictly on a technicality and the equities made the court reluctant to strike down the otherwise meritorious patent. The court said, at page 580 of 48 U. S. P. Q.:

> "We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed."

Can petitioner here contend that the limitations sought to be engrafted upon claims 6 and 7 by disclaimer were "implicit in the spirit of the invention claimed" when the patent specification states:

> "Whenever I refer to channel irons, I do not wish to be limited to any form of vertical supporting members, and I do not wish to be limited to an angle iron for completing the top of the metal construction."

Quaere, by disclaimer, may a patentee add to a granted patent claim for a combination of mechanical elements, other elements which his specification clearly states are not a part of his invention and not necessary to it?

The last two cases relied upon by petitioner in Section 2 of its brief require no refutation. The portions which petitioner quotes clearly harmonizes them with the controlling Altoona case.

We submit that nothing referred to by petitioner lessens the striking applicability of the ruling of the Supreme Court in the Altoona case to the considerations presented here and that the ruling of the learned court below should be affirmed.

8. Additional Authorities Opposing Petitioner's contentions and Petitioner's Alleged Authorities.

Among the abundance of decided cases which view with proper concern the right of the general public to be protected against iniquitous retroactive disclaimers and *ex post facto* charges of infringement are those which follow.

The following is from the opinion of the Circuit Court of Appeals in Enameled Metals Co. v. Western Conduit Co., 269 Fed. 620:

> "Nor can this disclaimer be permitted to limit the claims to an unthreaded sleeve which will fit closely or snugly over the threaded end, but loose enough to allow sufficient or a small amount of enamel to reach the threads to form a thin, rust-preventive coating, not sufficiently thick to require rechasing of the threads. In the disclosure in the application for this patent it is stated that, 'if desired, the sleeve can be made loose enough to allow sufficient or a small amount of enamel to reach the threads in the projecting portion of the coupling to prevent their rusting'; but there is nothing in the claims or in the disclosure in reference to a threaded or unthreaded sleeve. The claims cover all sleeves, threaded or unthreaded, loose or close-fitting, so that it is evident that this application was

made and allowed upon the theory that a protecting sleeve, of the kind described in the application and claims, involved invention, and not upon any theory that the invention consisted in a loose or unthreaded sleeve.

"The court is not now at liberty to usurp the functions of the Patent Office, and by forced construction, with the aid of the proposed disclaimer, issue in effect a new patent, limiting the claimed invention to a particular kind of sleeve, notwithstanding the essential element of the claimed invention consisted wholly in protecting the threads of the conduit by any 'fragile' sleeve suitable for that purpose. Kellogg Switch Board & Supply Co. v. Dean Electric Co., 257 Fed. 425-428, 168 C. C. A. 465 (C. C. A. 6)."

Here the Court held invalid a disclaimer which merely specified a conduit element to be unthreaded, where the claim previously was broad enough to include a conduit element either threaded or unthreaded.

The following excerpt from the Circuit Court of Appeals opinion in Grasselli Chemical Co. v. National Aniline & Chemical Co., 26 F. (2d) 305 if likewise enlightening.

"The question is whether a patentee may thus correct his generalization by successive retrenchment as he finds himself bound to retreat. If the part which the patentee disclaims need not be distinguishable on the face of the specification, there would never be need for a reissue on the second ground given in the statute, *i. e.*, 'by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new.' U. S. Code, tit. 35, Sec. 64 (35 USCA Sec. 64; Comp. St. 9461). This language must include something which cannot be reached by disclaimer, else it was redundant. We adhere to our ruling in Strause Gas Iron Co. v. Crane Co., (C. C. A.) 235 F. 126, that the distinction is between disclaiming a part separated in the patent itself as opposed to something comprehended in its general language. Hailes

v. Albany Stove Co., 123 U. S. 582, 8 S. Ct. 262, 31 L. Ed. 284; Albany Steam Trap Co. v. Worthington, 79 F. 966 (C. C. A. 2); Simplex Ry. Appliance Co. v. Pressed Steel Car Co., 189 F. 70 (C. C. A. 2). So far as the holding of the majority in Thompson v. N. T. Bushnell Co., 96 F. 238, 241, 242 (C. C. A. 2), is to the contrary, in view of our later rulings and of the other decisions cited, we cannot adhere to it."

"The distinction is not merely formal. If the specifications themselves separate the part disclaimed from that retained, that part is exscinded without affecting the residue which must be of itself enough to support the claims. True, the patentee has been wrong in asserting that the whole disclosure was new, but he has been right as to a part which does not depend upon what he disclaims. But when the specifications do not so separate the parts, the disclaimer can succeed only by interpolating a limitation into the part which must remain, if the claims are to survive. Nothing is taken out of the specifications, though something is taken out from their meaning. What is changed was originally false and has now by the added limitation been made true. This however is to reframe the language, not to drop out a part. It is not the office of a disclaimer to do this, but of a reissue."

It is fair reasoning under all of the decided cases to suggest a distinction as between claims originally intended and thought to be narrow, but accidentally susceptible of broad interpretation, and, on the other hand, claims intended to be broad, even though through ignorance of the prior art. In the latter case the meeting of the mind of the government and the patentee, in issuance of the patent, was based on false knowledge and must be entirely set aside. A new contract must be negotiated and this can only be done by renegotiation, and the only avenue is reissue of the defective patent.

9. Application of the Rule of Stare Decisis Does Not Lead to a Conclusion in Favor of Petitioner.

The petitioner admonishes this Honorable Court with respect to the principle of *stare decisis*. We have shown that there is no well settled line of authority supporting its position, quite apart from the compelling rule contra of the Altoona case. In connection with its discussion of *stare decisis* petitioner interposes a plea of necessity on the ground that vested property rights in patents will be destroyed by a decision against the instant disclaimers. This plea is not founded in fact. There is nothing to prevent the patentee here, or any others who find themselves in like situation by reason of having made invalid disclaimer, from subsequently pursuing their proper and supervised remedy under the reissue statute. AND THAT IS PRECISELY WHAT THE OWNERS OF THE VOGT PATENT IN THE ALTOONA CASE DID AFTER THE HOLDING OF INVALID DISCLAIMER BY THIS COURT. (Vogt *et al.* Reissue Letters Patent No. 20,621, dated January 11, 1938).

The petitioner stresses mainly Byrne Mfg. Co. v. American Flange & Mfg. Co., and, second in the order of discussion in petitioner's brief, Cincinnati Rubber Mfg. Co. v. Stowe-Woodward, Inc. Both of these cases were decided by the Sixth Circuit Court of Appeals, the same Circuit Court of Appeals which heartily approved District Judge Tuttle's philosophy in the Fruehauf case, discussed above. And this is the Circuit with which the petitioner mainly complains the unanimous ruling below is not in harmony.

Conclusion.

We believe it clear that elements are sought to be added by the accused disclaimers and that the claims are accordingly rendered invalid under the Altoona case, *supra*.

It is submitted that no beneficial contribution to the decided patent law can be effected by disturbing the holding of invalid disclaimer reached by the learned courts below in the instant case. There is certainly no reason founded in equity or in a desire for the fair administration of the patent laws for expanding the privilege of disclaimer beyond the present boundary set by the Altoona decision. This is ever more emphatically so when we consider the ready remedy afforded by the Reissue Statute, where the correction of the defective patent is subject to the scrutiny of a party vitally concerned in its reformation,—the people of the country through their government.

The Orr patent incontrovertibly anticipates claims 6 and 7 as they stood originally. The merest inspection of the Orr drawing and original Holdsworth claims 6 and 7 is conclusive on that point. How then can the claims as sought to be modified be other than either likewise anticipated or to different inventions from the original claims?

To put it another way, before the disclaimer a construction including a ceiling member without a depending flange could infringe; after the disclaimer, in addition to the ceiling member of claim 6, a depending vertical flange was required. With claim 7 the same situation obtains, with other elements added, as has been shown hereinbefore.

It is fundamental in the law that a document is to be construed most strictly against him who drew it. How much more so must that be true in the case where the other interested party not only did not draw it but had no right to see the disclaimer and in fact no knowledge of it until the document became officially a *fait accompli* by its mere lodgement in the Patent Office! It is submitted that under such circumstances equity requires that every reasonable doubt be resolved against the disclaimant.

An affirmance of the Courts below is respectfully prayed.

Respectfully submitted,

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CONRAD CHRISTEL,
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Date: